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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,849	12/11/2006	Shingo Odajima	288934US0PCT	5512

22850 7590 03/18/2010

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EXAMINER	
MULCAHY, PETER D	
ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
03/18/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/574,849	ODAJIMA ET AL.	
	Examiner	Art Unit	
	Peter D. Mulcahy	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/6/09*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *1-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/6/06,6/29/06,11/3/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *IDS 12/9/08*.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III, claims 6-17 in the reply filed on 11/16/09 is acknowledged. The traversal is on the ground(s) that the office must support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described. It is further argued that the "Office alleges that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for various reasons, and cites MPEP § 806.05(i) to support this allegation. In addition, the Office alleges that Groups I and III do not relate to a single general inventive concept for various reasons, and cites MPEP § 806.05(t') to support this allegation." This is not found persuasive because there is no special technical relationship linking the claims. The wax composition of claim 7 is the common technical feature and is known in the prior art (Trotoir US 5,053,444), as stated in the written restriction. Therefore there is a lack of unity

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

> person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polyisoprene rubber, does not reasonably provide enablement for "polymer". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The term "polymer" is of such a breadth so as to include vast array of chemical species that do not share structural similarities, properties and/or function. There is no reason for one of ordinary skill in the art to understand that every species falling within the scope "polymer" would function as described in the specification. Specifically the term "polymers" reads on polysiloxanes, polyurethanes, polyamides, cellulose, polyesters, polycarbonates, etc. The specification, in no way, enables all polymeric species falling within the scope of the term "polymer".

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Manson US 2,413,239.

6. This patent teaches forming a blend of polymer and wax and adding thereto a filler, see column 2 lines 4-17. The examples show compositions falling within the scope of the claimed percent limitations. As such all claim limitations are anticipated and the claim is not novel.

7. Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manson US 2,413,239 or Tobias et al. US 4,207,221 taken alone or in view of either Trotoir US 5,053,444 or Young et al. 2,595,911.

8. Manson and Tobias each show wax, polymer and filler compositions. These compositions can be formed by kneading the wax and polymer and subsequent addition of the filler, see Tobias at column 2 lines 65+ and column 4 lines 30-65, and Manson at column 2 lines 5+. The difference between these patents and the claimed invention is that claim 7 recites the formation of a masterbatch of polymer and wax. Each of the primary references teach the formation of a premix of polymer and wax. This initial mixing of the polymer and wax reads on the claimed masterbatch. The subsequent mixing of filler into the premix is disclosed. This is seen to read on the second kneading step. As such the use of a masterbatch to form the composition is obvious. The mixing particulars as claimed in 8-17 are seen as obvious design choices when forming a mixture. The metering in of various materials is known and conventional.

9. The Trotoir and Young et al patents are cited as clearly showing the use of masterbatch mixing techniques to form wax polymer compositions. This further

evidences the allegation of conventionality with respect to the mixing of various ingredients in various amounts so as to formulate a wax polymer composition. Trotoir at column 3 lines 25+ and Young at column 4 lines 50+ describes the sequential mixing so as to formulate the claimed compositions. One of ordinary skill would be motivated to subject the ingredients as mixed in the primary references to the mixing techniques described in the secondary references given the art recognized properties of the ingredients and the expectation of results.

10. The comparative examples in the specification have been fully considered. There are no unexpected results of record. The showing in the specification simply compares compositions having fillers with those that do no incorporate fillers. The art clearly shows the incorporation of fillers. The showing does not represent the closest art and does not support the breadth of the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796